

REMARKS

This application has been reviewed in light of the Office Action dated March 19, 2003, and the interview, by telephone, conducted on May 5, 2003, between one of Applicant's attorneys and the Examiner. Claims 1, 2, 8, 10-16, 22, 24-30, 36, and 38-40 remain pending in this application. Claims 3-7, 17-21, and 31-35 have been cancelled, without prejudice or disclaimer of subject matter. Claims 1, 2, 8, 10, 15, 16, 22, 24, 29, 30, 36, and 38 have been amended to define still more clearly what Applicant regards as his invention. Claims 1, 15, and 29 are in independent form. Favorable reconsideration is requested.

The Office Action rejected Claims 1-8, 10-22, 24-36, and 38-40 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,917,489 A1 (ThurLOW et al.). Cancellation of Claims 3-7, 17-21, and 31-35 renders their rejection moot. Applicant respectfully traverses the rejection of Claims 1, 2, 8, 10-16, 22, 24-30, 36, and 38-40.

The aspect of the present invention set forth in Claim 1 is an e-mail processing method that includes an identifying and a determining step. In the identifying step is identified a type of each of the data included in a received e-mail. In the determining step is made a determination as to whether each of the data included in the received e-mail can be processed, in accordance with the identified type of each of the data. In this method, when it is determined in the determining step that the received e-mail can be processed, the data is stored, and when it is determined in the determining step that the received e-mail cannot be processed, the data is deleted.

One important feature of Claim 1 is the determination made in the determining step, based on the identified type of each of the data in the e-mail, and the subsequent processing

based on the determination. Applicant notes that the features added to Claim 1 relating to whether or not the received e-mail can be processed were recited in cancelled Claims 3-5, are described in the specification at least at page 9, line 6, to page 10, line 1, and are shown in Figure 2. In addition, the data that are included in a received e-mail are shown in Figures 5 and 6. (It is to be understood, of course, that the scope of Claim 1 is not limited to the details of this embodiment.)

Thurlow et al., as understood by Applicant, relates to a system and method for creating, editing, and distributing rules for processing electronic messages. The Office Action states, at page 3, that Thurlow et al. "discloses an e-mail processing method comprising the steps of: identifying a type of each data included in a received e-mail, the received e-mail including a plurality of data; and determining whether each data included in the received e-mail is to be utilized in accordance with the identified type of each data." The Examiner cited column 6, lines 50-58; column 8, line 35, to column 9, line 3; column 9, lines 15-61; and column 10, lines 1-54 as support for these assertions.

Applicant submits that: i) column 6, lines 50-58, is directed to identifying electronic messages as units of data; ii) column 8, line 35, to column 9, line 3, is directed to a general description of the "OUTLOOK 97" desktop information manager; iii) column 9, lines 15-61, is directed to a description of the "Rules Wizard," which divides the process into discrete steps and apparently provides a user-friendly interface for creating and editing rules, where each rule includes conditions and actions; and iv) column 10, lines 1-54, is directed to a further discussion of the "Rules Wizard." In addition, with respect to "Outlook 97," Applicant submits Outlook 97 performs processing to an entire e-mail based on *fields* such as "To," "From," "CC,"

"Subject," "Date," and/or "Time" included in the e-mail. Even if Outlook 97 identifies such a *field*, however, Applicant has not found anything in the sections cited above, or any other sections of Thurlow et al., that would teach or suggest identifying a type of each *data* included in a received e-mail and determining whether each data included in the received e-mail can be processed, in accordance with the identified type of each data, as recited in Claim 1.

The Office Action also states, at page 3, that Thurlow et al. discloses, with regard to cancelled Claims 3 and 4, the features that "when it has been determined that a data is to be utilized, the e-mail is preserved as a file" and "when it has been determined that a data is not to be utilized, the data is not preserved." The Examiner cited column 12, lines 21-44, as support for these assertions. Applicant notes that this section discusses how a user interface allows a user to select actions that will take place when certain conditions are satisfied. Applicant submits, however, that nothing in this section, or any other section, of Thurlow et al. would teach or suggest determining whether each data included in the received e-mail can be processed, in accordance with the identified type of each data, and when the determining step determines that the received e-mail can or cannot be processed, the data is stored or deleted, respectively.

Accordingly, Applicant submits that at least for these reasons, Claim 1 is patentable over Thurlow et al.

Independent Claims 15 and 29 are apparatus and storage medium claims, respectively, that correspond to method Claim 1, and are believed to be patentable for at least the same reasons as discussed above in connection with Claim 1.

The other rejected claims in this application depend from one or another of the independent claims discussed above, and, therefore, are submitted to be patentable for at least the

same reasons. Since each dependent claim is also deemed to define an additional aspect of the invention, individual reconsideration of the patentability of each claim on its own merits is respectfully requested.

This Amendment After Final Action is believed to place this application in condition for allowance and, therefore, its entry is believed proper under 37 C.F.R. § 1.116. Accordingly, entry of this Amendment After Final Action, as an earnest effort to advance prosecution and reduce the number of issues, is respectfully requested. Should the Examiner believe that issues remain outstanding, it is respectfully requested that the Examiner contact Applicant's undersigned attorney in an effort to resolve such issues and advance the case to issue.

In view of the foregoing amendments and remarks, Applicant respectfully requests favorable reconsideration and early passage to issue of the present application.

Applicant's undersigned attorney may be reached in our New York Office by telephone at (212) 218-2100. All correspondence should continue to be directed to our address listed below.

Respectfully submitted,



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